

REMARKS

This Amendment is filed in response to the non-final Office Action dated September 6, 2007, and is respectfully submitted to be fully responsive to the objections and rejections raised therein. Accordingly, favorable reconsideration on the merits and allowance is respectfully submitted to be proper.

The amendments and how they respond to the objections and rejections set forth in the Office Action is explained below in detail.

In the present Amendment, claim 4 has been amended to correct a typographical error. Support for the amendment can be found in the specification at pages 8-10 at lines 12-2, respectively, and at Fig. 2, for example.

Claim 5 has been amended to correct claim dependencies and to incorporate the subject matter of claim 1.

Claims 6 and 7 have been amended to correct claim dependencies.

Claims 8 and 9, newly added, depend from claim 4 and further incorporates the subject matter of claims 2 and 3, respectively.

No new matter has been added. Support for the Amendment can be found in the original claims as filed.

Entry of the Amendment is respectfully submitted to be proper. Upon entry of the Amendment, claims 1-9 will be all the claims pending in the application.

Claim 4 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Examiner points out the inconsistency between claim 4 and other parts of the application.

Applicants traverse the rejection and request reconsideration and withdrawal of the rejection in view of the following remarks.

Claim 4 has been amended to correct a typographical error. Claim 4, as amended, recites that the ceramic powder covers a resin powder. In view of the amendment, Applicant respectfully request withdrawal of the rejection.

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly being obvious over -JP2003-160330 to Kato et al. ("Kato et al.").

The Examiner asserts that Kato et al. teaches an "almost identical process" for making a hollow ceramic particle as recited in claim 1, the difference being the rotation speed of the chamber. According to the Examiner, Example 1 of Kato et al. (Paragraph 21) teaches an identical rotation speed for the chamber as in Test 1 described in the present specification at pages 16 and 17. The Examiner concedes that Kato et al. does not explicitly teach the breaking strength or shell thickness of the particles as recited in claims 1 and 2. However, the Examiner's rejection is based on inherency, and has asserted that the materials and machinery of Kato et al. are identical to the instant application. The Examiner further states, alternately, that if the rotation speed has an effect on the particle properties, it would be obvious to one of ordinary skill in the art to vary the rotational speed to another speed that is taught in Example 1 of Kato et al. to obtain desired properties.

Applicants traverse.

As an initial matter, Applicants respectfully submit that Kato et al. is not prior art under 35 U.S.C. § 102(b) as of its publication date of June 3, 2003, which is not more than one year

from the PCT filing date of March 18, 2004. Thus, Kato must be removed as a section 102(b) prior art.

Additionally, Applicants submit that the currently claimed invention was made earlier than the publication of Kato et al. Accordingly, Applicants submit a verified English translation of foreign priority documents **JP 2003-77971** and **JP 2003-77972** together with a statement showing that the foreign priority documents have support for each claim under 35 U.S.C. § 112.

The publication date of Kato et al. is later in time than Applicants' priority date of March 20, 2003. Accordingly, the rejection is rendered moot because Kato et al. is no longer eligible as prior art under 35 U.S.C. §102(a). Therefore, withdrawal of the rejection is requested.

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 2002/0006986 to Igarashi ("Igarashi") in view of Kato et al.

According to the Examiner, Igarashi teaches an epoxy resin composition for encapsulating a semiconductor and further teaches that hollow inorganic filler is added to further reduce the dielectric constant of the epoxy resin (matrix). Further, Igarashi teaches that the hollow inorganic particles can be hollow spheres comprising a silicon oxide (silica) and an aluminum oxide (alumina) and the hollow spheres need to have a strong shell strength to withstand the heating and kneading-dispersion process that the resin and particles are subjected to. The particles should have a particle size of 110 microns or less, a shell thickness of 2 to 4 microns, and high compression strength (Paragraph 47). The Examiner further states that Kato et al. teaches particles that meet these limitations and have a strong, homogenous shell layer. According to the Examiner, it would be obvious to one of ordinary

skill in the art to use the particles of Kato, as the hollow particles of Igarashi, as they are of the correct size and strength to withstand the processing of the resin/particle composition.

Applicants traverse.

Applicants respectfully submit that in view of the verified English translation of Applicants' foreign priority documents Kato is not prior art and therefore cannot cure the deficiencies of Igarashi.

Igarashi alone, does not appear to teach or suggests the elements of claim 4 because the reference fails to describe in particular hollow ceramic particles-containing composite material comprising hollow ceramic particles in a matrix. Furthermore, Igarashi does not teach or suggest a porous shell layer comprising ceramic powders bonded to each other. Further, the hollow inorganic filler described in Igarashi is not obtained by a sintering precursor comprising ceramic powder covering a resin powder wherein the ceramic is embedded in the resin, as recited in claim 4. Thus Igarashi does not teach or suggest the features of claim 4.

Claims 5-7 are objected to under 37 C.F.R. § 1.75(c) as being improperly dependent claims.

Claims 5-7 have been amended to improve their form. Applicants respectfully request reconsideration and withdrawal of the objection in view of the amendment to claims 5-7.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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